



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#27/K.T.
6/10
TERM.
Disclaimer

In re application of:

NGUYEN *et al.*

Appl. No. 09/227,881

Filed: January 11, 1999

For: **Nucleic Acids, Kits and Methods
for the Diagnosis, Prognosis and
Treatment of Glaucoma and
Related Disorders**

Art Unit: 1635

Examiner: Mary SCHMIDT

Atty. Docket: 16491.066

TECH CENTER 1600/2900

JUN 10 2002

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Terminal Disclaimer

Commissioner for Patents
Washington, D.C. 20231

Sir:

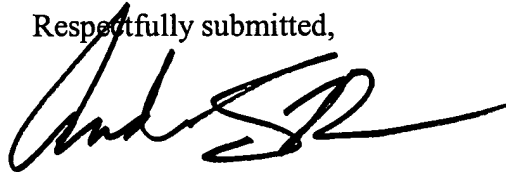
The Regents of the University of California (hereinafter the "Owner"), the assignee and owner of the entire right, title, and interest in the instant application by virtue of the assignment recorded on October 8, 1999, hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application that would extend beyond the last day of the full statutory term of any patent granted on commonly owned Patent Number 6,171,788, issued on January 9, 2001 (hereinafter the "Prior Patent"). The Owner hereby agrees that any patent granted on the instant application shall be enforceable only for and during such period that it and the Prior Patent are commonly owned and agrees that this Terminal Disclaimer shall run with any patent granted on the instant application and shall be binding on the grantee, its successors or assigns.

The owner does not disclaim any terminal part of any patent granted on the instant application prior to the expiration date of the full statutory term of the Prior Patent, as shortened by any terminal disclaimer, in the event that the Prior Patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is

statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321(a), has all claims canceled by a reexamination certificate, is reissued, or is otherwise prematurely terminated except as provided by a terminal disclaimer as recited above.

The fee set forth in 37 C.F.R. § 1.20(d) is believed to be \$110.00. The Commissioner is hereby authorized to charge Arnold & Porter Deposit Account Number 50-1824 for any fee deficiency required for this filing, referencing docket no. 16491.066.

Respectfully submitted,



Joel M. Freed (Reg. No. 25,101)
Andrew Brenc (Reg. No. 45,534)
William E. Sekyi (Reg. No. 45,831)

Date: June 4, 2002

ARNOLD & PORTER
555 Twelfth Street, N.W.
Washington, D.C. 20004-1206
(202) 942-5000 telephone
(202) 942-5999 facsimile

CORRECTION OF PATENTS

1490

T. D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 6-10-08TO: EXAMINER Schmidt, MAPPL. S.N.: 9-297,881

FROM: _____

ART UNIT: 1635

SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: _____

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete, please initial, date and return this memo to me. THANK YOU.

- ☒ The T.D. is PROPER and has been recorded (see ¶14.23).
- ☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶14.24):
- ☐ The recording fee of \$ _____ has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶14.26.07).
 - ☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see ¶¶14.26 & 14.26.01).
 - ☐ The T.D. lacks the enforceable only during common ownership clause - needed to overcome a double patenting rejection, Rule 321(b) (see ¶14.27.01).
 - ☐ The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be a terminal portion of the term of the entire patent to be granted." (MPEP 1490) (see ¶¶14.26 & 14.26.02).
 - ☐ The person who signed the T.D.:
 - ☐ is not an attorney "of record" (see ¶¶14.29 and 14.29.01).
 - ☐ has failed to state his/her capacity to sign for the business entity (see ¶14.28).
 - ☐ is not recognized as an officer of the assignee (see ¶¶14.29 & possibly 14.29.02).
 - ☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶14.30).
 - ☐ The T.D. is not signed (see ¶¶14.26 & 14.26.03).
 - ☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶14.32).
 - ☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶¶14.26, 14.26.04 or 14.26.05).
 - ☐ The period disclaimed is incorrect or not specified (see ¶¶14.26, 14.27.02 or 14.27.03).
 - ☐ Other:
 - ☐ Suggestion to request refund (see ¶14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex. Initials: _____ Date: _____

RETURN THIS MEMO TO CPK2-2D25.

(Rev. 5/98)